

REMARKS

Applicants and the undersigned thank Examiners Morgan and Thomas for the courtesies they extended to Mr. Kramer, Mr. Riggs, Dr. Kirsh, and the undersigned during the interview of October 19, 2005. The remarks below, in conjunction with the Interview Summary, reflect what was discussed at the interview.

New claims 15-21 have been added. New independent claim 15 includes the features of associating the appeal data with one or more bases for an appeal, generating an appeal form based on at least one of the associated bases and according to a predetermined format, and sending the formatted appeal to an appeals unit. New independent claim 21 includes the features of processing the stored appeal data to identify a basis for an appeal, generating an appeal form comprising the identified basis for the appeal and according to a predetermined format, and sending the formatted appeal to an appeals unit. In the interview, the Examiners stated that none of the cited references discloses these claimed features. Support for these new claims can be found at least in paragraphs [0149], [0185], the Abstract, and in figures 1, 3 and 4. An early action allowing claims 15-21 is solicited.

Claims 1, 3, 4, 6-8, and 13-14 stand rejected under 35 USC 103(a) as unpatentable over Burchetta. Claims 2, 11, and 12 stand rejected under 35 USC 103(a) as unpatentable over Burchetta in view of Israel. Claim 5 stands rejected as unpatentable over Burchetta in view of Israel and further in view of Barber. Claims 9 and 10 stand rejected under 35 USC 103(a) as unpatentable over Burchetta in view of Official Notice. These rejections are respectfully traversed.

Each of the independent claims 1-4, 6-8, and 11-14 recites a request for reconsideration of an adjudicated claim and stands rejected based on Burchetta. In the Action, the Examiner characterized Burchetta as a computerized system for automated dispute resolution capable of resolving a dispute with an insurer. However, the Examiner admitted that Burchetta fails to explicitly teach an appeal that is a request for reconsideration of a claim adjudicated by an insurer.

The Examiner recognized this shortcoming of Burchetta and stated at page 4 of the Action that “[t]he Examiner considers a dispute [of Burchetta]...as a claim that has been adjudicated by one of the parties involved such as the insurer.” Applicants respectfully submit that Burchetta does not teach or suggest that an “appeal” that is “a request for reconsideration of a claim adjudicated by an insurer.” Burchetta only describes that a “demand” is “the amount of money required by the person having a claim...against another person...such as a defendant or his insurer, for which the person with the claim would be willing to settle.” (Col. 3, lines 54-57.) In contrast to the claimed invention, Burchetta presupposes that a cognizable claim for money against an insurer or another party already exists.

As discussed in the interview, the systems and methods described by the claims do not assume that an individual has a claim for any amount of money. Rather, the pending claims relate to sending information to an appeal unit for reconsideration of a determination of an entitlement to benefits or services. The claimed invention does not involve a demand for money or the transfer of any amount of money from one party to another, *per se*. The present invention is not directed to and does not claim a negotiation process.

Burchetta, however, only describes a negotiation process whereby two parties can negotiate a specific dollar amount for settlement of a claim. Applicants submit that there is no suggestion anywhere in Burchetta that the described negotiation process in any way involves a claim that has been adjudicated by an insurer. All Burchetta describes is a series of rounds of corresponding demands and offers.

Because Burchetta clearly fails to teach the claimed “request for reconsideration of a claim adjudicated by an insurer,” the Examiner attempted to provide that teaching without relying on Burchetta by simply stating what the Examiner considers the dispute of Burchetta to be. Applicants respectfully submit that while the Examiner may consider the dispute of Burchetta to be as he has described it, the Examiner has not identified any basis in Burchetta for the Examiner’s conclusion.

The Examiner's unsupported statement that he considers the dispute of Burchetta to be a claim that has been adjudicated by one of the parties, such as an insurer, is an insufficient and improper basis for a rejection of the claims. The Federal Circuit has made clear that the Office cannot make such unsupported statements to support a rejection. For example, see *In re Zurko*, 61 USPQ2d 1693, 1697 (Fed. Cir. 2001) which states:

...With respect to core factual findings in a determination of patentability, however, the [Patent Office] cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense. Rather, the [Patent Office] must point to some concrete evidence in the record in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise.

See also, *In re Lee*, 61 USPQ2d 1430, 1437 (Fed. Cir. 2002) (quoting *Zurko* to show that the Patent Office must provide documented evidence and cannot rely on general conclusions about what is "basic knowledge and "common sense"). Thus, the Federal Circuit has made it clear that the Examiner's unsupported supposition that the dispute of Burchetta is a claim that has been adjudicated by one of the parties involved, such as an insurer, cannot form the basis for a rejection of the claims.

Applicants submit that not only does the prior art not show a request for reconsideration of a claim adjudicated by an insurer, but the Examiner has not identified any motivation in the prior art to apply a computerized dispute resolution system to an appeal that is a request for reconsideration of a claim adjudicated by an insurer. In the Action, the Examiner stated that the basis for such a combination arises from the "motivation of providing accurate appeal information thereby allowing the opportunity for involved parties to successfully settle their claims easily, effectively and inexpensively."

Applicants submit that the motivation provided by the Examiner, a motivation provided without any reference to any teaching in the prior art, is improper. When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available

to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references.” *In re Lee*, 61 USPQ2d at 1434. “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Citing *In re Dembiczak*, the Board in *Ex parte Bostrom* (Unpublished BPAI opinion in Appeal No. 2000-0338), concluded that the Examiner’s “broad conclusory statements of ‘insuring correct and accurate sensors’ and accomplishing ‘a versatile, robust system that would work in a myriad of weather conditions,’ standing alone, are not evidence.” Applicants submit that the Examiner’s rationale for the combination in this case, a statement of the purported benefits of the combination without any reference to the prior art itself, is no better supported than the rationale found to be insufficient in *Ex parte Bostrom* which may not be “precedential” but is indicative of how the Board addresses this type of issue.

Applicants therefore submit that no prior art reference or record teaches the claimed systems and methods including an appeal that is a request for reconsideration of an adjudicated claim. Dependent claims 5, 6, 9 and 10 each depend from an independent claim reciting this feature and are therefore also allowable for the reasons given above with regard to the independent claims.

Early action allowing claims 1-21 is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing Docket No. 462322000100.

Respectfully submitted,

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